

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT J. BROUSSARD

Appeal No. 2007-0279
Application 10/042,079
Technology Center 2100

Decided: March 20, 2007

Before JOSEPH F. RUGGIERO, LANCE LEONARD BARRY,
and JEAN R. HOMERE, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals from the Examiner's final rejection of claims 1 through 39 pursuant to 35 U.S.C. § 134. We have jurisdiction under 35 U.S.C. § 6(b) to decide this appeal.

The Examiner rejects the pending claims as follows:

- A. Claims 1, 7, 10 through 14, 20, 23 through 27, 33, and 36 through 39 stand rejected under 35 U.S.C. § 102 (e) as being anticipated by Krishna.
- B. Claims 2, 4 through 6, 8, 9, 15, 17 through 19, 21, 22, 28, 30 through 32, 34, and 35 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over the combination of Krishna and Green.
- C. Claims 3, 16, and 29 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over the combination of Krishna, Green and Evans.

The Examiner relies on the following references:

Lewis	US 5,590,331	Dec. 31, 1996
Lee	US 2002/0147763 A1	Oct. 10, 2002 (filed Oct. 10, 2000)
Krishna	US 2003/0051233 A1	Mar. 13, 2003 (filed Sept. 13, 2001)
Evans	US 6,836,884 B1	Dec. 28, 2004 (filed Jun. 4, 2001)

Dale Green, *Trail: The Reflection API*, The Java Tutorial (Nov. 27, 1999), <http://java.sun.com/docs/books/tutorial/reflect/>, 1-36.

Independent claim 1 is illustrative and representative of the Appellant's invention. It reads as follows:

1. A method in a data processing system for generating a generic compilation interface, from a first object-oriented software package, said method comprising the steps of:

identifying all public classes included in said first object-oriented software package;

for each of said public classes, identifying all public entities included in each of said public classes;

removing all references to software that is defined in a second object-oriented software package from said public entities included in each of said public classes;

generating an equivalent public class for each of said identified public classes, said equivalent public class including equivalent public entities that include no references to said software defined in said second object-oriented software package;

compiling each of said equivalent public classes; and

generating a compilation interface for said first object-oriented software package including each of said compiled equivalent public classes.

Appellant contends that claims 1, 7, 10 through 14, 20, 23 through 27, 33, and 36 through 39 are not anticipated by Krishna.¹ Particularly, Appellant contends that Krishna does not fairly teach or disclose the feature of removing all references to a software that is defined in a second object-oriented package, as recited in representative claim 1. (Br. 11).

The Examiner contends that Krishna teaches the claimed limitation of removing all references to a software that is defined in a second object-oriented package as excluding source code executable statements during the creation of library stubs. (Answer 5). The Examiner then concludes that Krishna anticipates claims 1, 7, 10 through 14, 20, 23 through 27, 33, and 36 through 39. Additionally, the Examiner concludes that Krishna, taken in various combinations with Green and Evans, renders claims 2 through 6, 8, 9, 15 through 19, 21, 22, 28 through 32, 34, and 35 unpatentable.

¹ This decision considers only those arguments that Appellant submitted in the Appeal Brief. Arguments that Appellant could have made but chose not to make in the Brief are deemed to have been waived. See 37 C.F.R. § 41.37(c)(1) (vii)(eff. Sept. 13, 2004). *See also In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

We reverse.

ISSUES

The *pivotal* issues in the appeal before us are as follows:

- (1) Under 35 U.S.C. § 102(e), does Krishna anticipate the claimed invention when Krishna teaches using declarations and interfaces of a first object-oriented software program while excluding executable statements of the first object-oriented software program to generate an interface (library stubs) for compiling a second object-oriented software program?
- (2) Under 35 U.S.C. § 103(a), would one of ordinary skill in the art at the time of the present invention, have found that Krishna, taken in combination with Green or Evans, renders the claimed invention unpatentable?

FINDINGS OF FACT

Appellant invented a method, system and computer program product for using object-oriented software codes from a first software package (402) to generate a generic compilation interface (432) to compile object-oriented software codes for a second object-oriented software package (Specification 1, 15). Particularly, as depicted in figure 4, the invention identifies all public classes and entities in the first object-oriented software package. Then, it removes all references to the first software to subsequently generate equivalent public classes and entities, which are used to generate the compilation interface. (Specification 15).

Krishna discloses an interface (220) for compiling a second object-oriented software program (180) from a first object-oriented software

program (110).² Particularly, as depicted in figure 2, Krishna uses declarations and interfaces of the first object-oriented software program to generate an interface or library stubs (220) for compiling codes in a second object-oriented software program. However, Krishna teaches excluding the executable statements of the first object-oriented software while generating the library stubs. (Page 2, paragraph [0025]).

PRINCIPLES OF LAW

1. ANTICIPATION

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed Cir. 1999) (“In other words, if granting patent

² We note in the first sentence of the abstract, Krishna specifically indicates that the first software program is capable of being *referenced* by the second software program. (Abstract, ll. 1-2).

protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

2. OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. Thus, the Examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the Examiner’s conclusion

ANALYSIS

As set forth above, Appellant’s invention requires removing *all references* to software in a second object-oriented software package to generate a compilation interface from a first object-oriented software package. In contrast, as set forth in the statement of facts section above,

Krishna teaches using source code declarations and interfaces while excluding source code executable statements to create the library stubs. We find that Krishna's exclusion of the executable statements, while including the declarations and interfaces of the first objected-oriented software in generating the library stubs, amounts to a partial exclusion of references to the first software. Krishna is devoid of a clear teaching that excludes the declarations, the interfaces, the executable statements and any other references to the first object-oriented software. Therefore, it cannot be properly relied upon to anticipate Appellant's invention, as set forth in representative claim 1. Furthermore, the Examiner failed to persuade us that the declarations and interfaces of the first object-oriented software to create the library stubs to compile codes in the second object-oriented software, as taught by Krishna, are not references to the first object-oriented software. After considering the entire record before us, we find that the Examiner erred in rejecting representative claim 1 as being anticipated by Krishna. We also find for the same reasons that the Examiner erred in rejecting claims 7, 10 through 14, 20, 23 through 27, 33, and 36 through 39 as being anticipated by Krishna.

Next, we find that the Examiner improperly rejected dependent claims 2 through 6, 8, 9, 15 through 19, 21, 22, 28 through 32, 34, and 35 as being unpatentable over Krishna, taken in various combinations with Green and Evans. We find that neither Green nor Evans was relied upon for the limitation of removing *all references* to software in a second object-oriented software package to generate a compilation interface from a first object-oriented software package. Further, we find that neither reference teaches such limitation to cure the deficiencies of Krishna. After considering the

entire record before us, we find that the Examiner erred in rejecting dependent claims 2 through 6, 8, 9, 15 through 19, 21, 22, 28 through 32, 34, and 35 as being unpatentable over Krishna, taken in various combinations with Green and Evans.

CONCLUSION OF LAW

On the record before us, Krishna does not anticipate the claimed invention under 35 U.S.C. § 102 (e) when Krishna teaches using declarations and interfaces of a first object-oriented software program while excluding executable statements of the first object-oriented software to create library stubs to generate an interface to compile a second object-oriented software program. Further, one of ordinary skill in the art at the time of the present invention, would not have found that Krishna, taken in various combinations with Green and Evans renders the claimed invention unpatentable under 35 U.S.C. § 103(a).

DECISION

We reverse the Examiner's decision to reject claims 1, 7, 10 through 14, 20, 23 through 27, 33, and 36 through 39 under 35 U.S.C. § 102 (e) as being anticipated by Krishna. We also reverse the Examiner's decision to reject claims 2 through 6, 8, 9, 15 through 19, 21, 22, 28 through 32, 34, and 35 under 35 U.S.C. § 103(a) as being unpatentable over Krishna, taken in various combinations with Green and Evans.

Appeal 2007-0279
Application 10/042,079

REVERSED

rwk

IBM CORP (YA)
C/O YEE & ASSOCIATES PC
P.O. BOX 802333
DALLAS TX 75380